

REMARKS

Claims 1-20 are rejected under 35 U.S.C. §103 as being unpatentable over *Crouse et al.* (U.S. 5,634,022) in view of *Wookey* (U.S. 6,151,683). Applicants traverse this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

The present invention claims:

Claim 1. A method of updating diagnostic information comprising:
detecting machine information;
detecting diagnostic information corresponding to the machine information;
including updated diagnostic script, application and information in a first computer;
communicating the updated diagnostic script, application and information to a second computer via a network; and
causing one of a plurality of diagnostic routines supported by the machine to be selectable for execution according to the diagnostic information, and to cause another of the diagnostic

routines, not supported by the machine, to become not selectable for execution.

- Claim 7. A computer system comprising:
- a first computer including:
 - a processor; and
 - a memory coupled to the processor;
 - the memory including a diagnostic script, a diagnostic application including a plurality of diagnostic routines, updated diagnostic information, and machine information;
 - the diagnostic script being executable by the processor to cause the machine information to be read, to cause a portion of the updated diagnostic information corresponding to the machine information to be read, and to cause one of the plurality of diagnostic routines in the diagnostic application supported by the computer system to become selectable for execution by the processor according to the portion of the updated diagnostic information, and to cause another of the diagnostic routines, not supported by the computer system, to become not selectable for execution;
 - a second computer;
 - a communications network;
 - the first computer and second computer being configured to communicate using the communications network; and
 - the first computer being configured to detect second diagnostic information on the second computer and to receive and update the second diagnostic information.

Claim 20. A computer system comprising:

- a first computer including:
 - a processor;
 - a memory coupled to the processor;
 - the memory including a diagnostic script, a plurality of diagnostic routines, first diagnostic information, and machine information;
 - the diagnostic script being executable by the processor to cause the machine information to be read, to cause a portion of the first diagnostic information corresponding to the machine information to be read, and to cause one of the plurality of diagnostic routines supported by the computer system to become selectable for execution by the processor according to the portion of the first diagnostic information, and to cause another of the diagnostic routines, not supported by the computer system to be not selectable for execution;
- a second computer;
- a communications network;
- the first computer and second computers being configured to communicate using the communications network; and
- the first computer being configured to detect and compare second diagnostic information on the second computer and to receive the second diagnostic information;
- whereby updated diagnostic script, diagnostic routines and diagnostic information in the first computer is communicated to the second computer via the communications network.

The references do not teach or suggest updating diagnostic script, application and information between first and second computers using a communications network.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO “failed to establish a prima facie case of obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant’s disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had “reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious.” The court noted that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.” The court further noted that there were three possible sources for such motivation, namely “(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of

persons of ordinary skill in the art.” Here, according to the court, the board had relied simply upon “the high level of skill in the art to provide the necessary motivation,” without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: “If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.”

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection since neither *Crouse et al.* patent nor the *Wookey* patent teaches or even suggests the desirability of the combination. Moreover, neither patent provides any incentive or motivation supporting the desirability of the combination.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).


Therefore, the Examiner’s combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

Therefore, independent claims 1, 7 and 20 and the claims dependent therefrom are submitted to be allowable.


In view of the above, it is respectfully submitted that claims 1-12 and 20 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,


James R. Bell
Registration No. 26,528

Dated: 2-4-04
HAYNES AND BOONE, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 214/200-0853
ipdocketing@haynesboone.com

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